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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,478	04/22/2005	Hideki Ihara	10830-4US (542081)	3852
570 7590 01/24/2007 AKIN GUMP STRAUSS HAUSER & FELD L.L.P. ONE COMMERCE SQUARE 2005 MARKET STREET, SUITE 2200 PHILADELPHIA, PA 19103			EXAMINER SCHLIENTZ, NATHAN W	
			ART UNIT	PAPER NUMBER
			1616	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/24/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/532,478

Applicant(s)

IHARA ET AL.

Examiner

Nathan W. Schlientz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

The preliminary amendment filed 22 April 2005 has been entered. Claims 1-11 are pending. No claim is allowed at this time.

Claim 11 is a duplicate of claim 5. The Applicant should cancel one of the claims, or one of the claims will be canceled if the claims are found to be allowable.

#### ***Information Disclosure Statement***

1. The information disclosure statement filed 22 April 2005 has the foreign patent DE 30 30 661 A1 that fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it is not in the English-language. The information referred to therein has not been considered as to the merits, and the reference has been crossed out on the information disclosure statement. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

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obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10/530,136 (hereinafter '136). Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to a 1,2,4-thiadiazole compound, an arthropod controlling composition comprising the said compound, and a method for controlling arthropod pests comprising applying said compound. Many of the 1,2,4-thiadiazole compounds are overlapping in scope, and some of the said compounds are identical. Therefore, the scope of the copending claims overlap and thus they are obvious variants of one another.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 6-8 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for all arthropods, does not reasonably provide enablement for Hemiptera, Lepidoptera, Diptera, Coleoptera, Thysanoptera, Hymenoptera, Dictyoptera, Orthoptera, Anoplura, Isoptera, and Acarina. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

Attention is directed to *In re Wands*, 8 USPQ2d 1400 (CAFC 1988) at 1404 where the court set forth the eight factors to consider when assessing if a disclosure would have required undue experimentation. Citing *Ex parte Forman*, 230 USPQ 546 (BdApl 1986) at 547 the court recited eight factors:

- 1) the nature of the invention
- 2) the state of the prior art
- 3) the relative skill of those in the art
- 4) the predictability of the art
- 5) the breadth of the claims
- 6) the amount of direction or guidance provided
- 7) the presence or absence of working examples
- 8) the quantity of experimentation necessary

The instant specification fails to provide guidance that would allow the skilled artisan to practice the instant invention without resorting to undue experimentation, as discussed in the subsections set forth herein below.

*The nature of the invention*

The claimed invention relates to an arthropod controlling composition and a method for controlling arthropod pests comprising a 1,2,4-thiadiazole compound. The Merriam-Webster OnLine dictionary defines arthropod as any of a phylum of invertebrate animals (as insects, arachnids, and crustaceans) that have a segmented body and jointed appendages, a usually chitinous exoskeleton molted at intervals, and a dorsal anterior brain connected to a ventral chain of ganglia. The Encyclopædia Britannica includes lobsters, crabs, spiders, insects, centipedes, and millipedes in the term arthropod.

*The state of the prior art*

The state of the art is well developed with respect to controlling insect pests, acarine pests and the like with various pesticides, including 1,2,4-thiadiazole compounds (EP 0273534).

*The breadth of the claims*

The claims are very broad in that they are directed at controlling all arthropods. Given the broadest reasonable interpretation of the term arthropod includes insect pests, acarine pests, arachnids and crustaceans such as lobsters and crabs.

*The amount of direction or guidance provided*

The specification does not give direction or guidance with respect to determining the efficacy of the 1,2,4-thiadiazole compounds ability to control all arthropods. The specification states the ability to control arthropod pests which includes Hemiptera, Lepidoptera, Diptera, Coleoptera, Thysanoptera, Hymenoptera, Dictyoptera, Orthoptera,

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Anoplura, Isoptera, and Acarina. However, the specification does not provide any guidance for the control of other arthropods, such as lobsters, crabs, etc.

*The presence or absence of working examples*

The specification provides working examples where *Aphis gossypii* (cotton aphid) are sprayed with a variety of test 1,2,4-thiadiazole compounds while feeding on a cucumber plant. These examples show the ability of the 1,2,4-thiadiazole compounds to control Hemiptera. However, there are no working examples of controlling other arthropod species.

*The quantity of experimentation necessary*

In order for a person skilled in the art to determine the efficacy of the 1,2,4-thiadiazole compounds against all arthropods would require undue experimentation.

Therefore, for the aforementioned reasons, the Applicant is enabled for Hemiptera, Lepidoptera, Diptera, Coleoptera, Thysanoptera, Hymenoptera, Dictyoptera, Orthoptera, Anoplura, Isoptera, and Acarina, but is reasonably enabled for all arthropods.

2. Claim 8 provides for the use of the 1,2,4-thiadiazole compound according to claim 1, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

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Claim 8 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

#### **Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan W. Schlientz whose telephone number is 571-272-9924. The examiner can normally be reached on 8:30 AM to 5:00 PM, Monday through Friday.

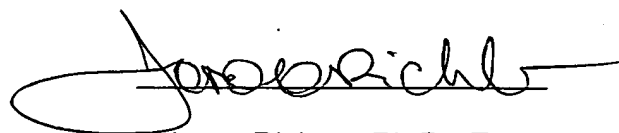
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nathan W. Schlientz, Ph.D.  
Patent Examiner  
Technology Center 1600

A handwritten signature in black ink, appearing to read 'Johann Richter', with a large, stylized loop at the beginning and a horizontal line extending to the right.

Johann Richter, Ph.D., Esq.  
Supervisory Patent Examiner  
Technology Center 1600